

REMARKS

Upon entry of this amendment, claims 1-20, 34 and 38-53 are pending. Claims 1, 5-13, 38, and 41-48 have been amended; claims 14-20 and 34 have been withdrawn from consideration; claims 21-33 and 35-37 have been canceled; and new claims 50-53 have been added.

Reconsideration of the application in light of the amendments and the below remarks is respectfully requested.

In the office action mailed September 9, 2005, the examiner:

- rejected claims 1-13 and 38-49 under 35 U.S.C. § 101 as allegedly abstract ideas that do not produce a “concrete” and “tangible” result; and
- rejected claims 1-13 and 38-49 under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 6,755,743 to Yamashita et al. (“the Yamashita patent”).

35 U.S.C. § 101

Claims 1-13 and 38-49 stand rejected under 35 U.S.C. § 101 as allegedly abstract ideas that do not produce a “concrete” and “tangible” result.

Independent claims 1 and 38 have been amended to recite, *inter alia*,

“... recording a winning and a losing participant of an engagement for each of said competitive partners in said selected round; and removing said losing participant of each of said competitive partners from further participation in said competitive event.”

Independent claims 1 and 38 provide the useful result of “recording a winning and a losing participant of an engagement . . . and removing said losing participant . . . from further participation in said competitive event.” Thus, independent claims 1 and 38 do not represent a mere abstract idea, but instead recite a practical application, namely the use of the competitive partner selection process to implement the concrete and tangible result of “recording a winning and losing participant.” The Court of Appeals for the Federal Circuit has held that a process claim that applies a mathematical algorithm to “produce a useful, concrete, tangible result

without pre-empting other uses of the mathematical principle, on its face comfortably falls within the scope of § 101.” See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). The present claims do not pre-empt all uses of the selection principle recited in the claims, but only those which produce the recited practical result.

Applicant, therefore, requests that the 35 U.S.C. § 101 rejection of independent claims 1 and 38 be withdrawn, and that these claims be withdrawn. With respect to claims 2-23 and 39-49, which depend from independent claims 1 and 38, respectively, and which recite additional features of the invention, applicant requests that the 35 U.S.C. § 101 rejections of these claims be withdrawn for the same reasons as stated for claims 1 and 38.

### 35 U.S.C. § 103(a)

Claims 1-13 and 38-49 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by the Yamashita patent. Independent claims 1 and 38 are patentable over the Yamashita patent because that reference fails to disclose, teach or suggest all of the limitations of the claims.

Specifically, independent claim 1 is directed to a method of determining competitive partners from among a plurality of participants in a selected one of a plurality of rounds in a competitive event wherein the participant with the highest rank selects any second participant to form a competitive partner pair. The process is repeated to obtain a plurality of competitive partner pairs for the selected round. Claim 38 is similar except that participants are first organized into groups and members of one group, in rank order, select another participant to form a plurality of competitive partner pairs for the selected round.

The Yamashita patent, by contrast, does not have the claimed rank order selection system. Instead it discloses a communication game system in which one player can challenge another player to a battle. (See the Yamashita patent, col. 1, lines 7-10; col. 12, lines 28-30.) When one player (client system 1A) applies for a battle, the second player (client system 1B), answers whether or not he accepts the battle. (See *id.*, col. 12, lines 48-56 and Fig. 2.) Since the second player can refuse, there is not necessarily a winner and loser to be recorded for each of said competitive partner pairs, nor is a competitive partner pair necessarily formed. Further, the

Yamashita patent does not disclose that ranks are used to determine which participant - of those remaining in the group - is allowed to make the next selection of an opponent. Thus, the Yamashita system does not disclose the system of claim 1, in which the participant with the highest rank selects any second participant to form a competitive partner pair, and in which this rank selection process is repeated to obtain a plurality of competitive partner pairs for a selected round. Likewise, the Yamashita system does not disclose the system of claim 38, in which the participants are first organized into groups and where members of one group, in rank order, select another participant to form a plurality of competitive partner pairs for the selected round.

The Yamashita patent further describes a "tournament battle" mode. (*See id.*, col. 25, lines 56-58.) But even in this "tournament" mode, *the host client system*, not the participants in rank order, sets up the tournament combinations among the battle participating members in the tournament battle. (*See id.*, col. 26, lines 2-4; col. 26, lines 40-42.) Thus, this tournament mode is distinct from claims 1 and 38 because it does not allow the participants to select their opponent, so that the Yamashita patent does not disclose, teach or suggest the presently claimed subject matter.

Applicant, therefore, requests that the 35 U.S.C. § 103(a) rejection of independent claims 1 and 38 be withdrawn. With respect to claims 2-13 and 39-49, which depend from claims 1 and 38, respectively, and which recited additional features of the invention, applicant requests that the 35 U.S.C. § 103(a) rejections of these claims be withdrawn for the same reasons as stated for claims 1 and 38.

#### **New Claims 50 through 53**

New claims 50, 51; and 52, 53 depend from independent claims 1 and 38, respectively, and recite additional features of the invention. Thus, claims 50 through 53 are allowable for the same reasons as stated above for claims 1 and 38.

The pending claims are believed to be in condition for allowance. Reconsideration and allowance are requested. If a telephone conference would be of assistance in advancing prosecution of the above-identified application, applicants' undersigned attorney invites the examiner to telephone him at 609-631-2491.

No fees are believed to be due with this submission. Should any fees be required, the Commissioner for Patents is hereby authorized to charge such required fees to deposit account 50-2061.

Respectfully submitted,

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